

112 of claim 6 in view of the foregoing amendment . The plural terms have been singularized as requested by the examiner, and the location of the radicals is more specifically recited.

The Examiner has rejected claims 1-6 under 35 USC 103 as being unpatentable over Green {U.S. Pat. 4,617, 154} in view of Sullivan, III et al. {U.S. Pat. 4,231, 956} and O'Lenick, Jr. et al. {U.S. Pat. 5, 196, 589}. This rejection is traversed for the following reasons:

Green teaches a process of making a β -alkoxynitrile by reacting an α,β -unsaturated nitrile with an alcohol in the presence of a diazabicycloalkene catalyst (Michael-type addition). Green does not teach the subsequent catalytic hydrogenation of the β -alkoxynitrile. Likewise, Sullivan III relates to the Applicant's first step, a Michael-type addition, but does not relate to the Applicant's second step of catalytic hydrogenation of the β -alkoxynitrile. O'Lenick, Jr. et al. discloses a Michael-type addition reaction coupled with subsequent catalytic hydrogenation.

Thus, none of the references disclose the applicants' process which involves the use of diazabicycloalkene as catalyst in the first step and subsequent hydrogenation in the presence of both the diazabicycloalkene catalyst and a hydrogenation catalyst.

As noted by the applicants at page 1, lines 31 to 41, a person of ordinary skill would have either removed the basic catalyst used in the Michael-type addition or neutralized the same before proceeding with the subsequent hydrogenation of the β -alkoxynitrile. The

state of the art with respect to this point is borne out by the citation of H.A. Bruson, Organic Reactions, Vol. 5, page 90, paragraph 3, lines 8-11. The applicants discovered that where diazabicycloalkene is employed as the catalyst in the first step the second step (hydrogenation) removal or neutralization may be avoided and without loss of yield. This point is clearly made in the examples in the applicants' specification. In "Inventive" example 5, representative of the applicants' process, the Michael-type addition is conducted using diazabicycloalkene as catalyst, and the catalytic hydrogenation is conducted in the presence of the diazabicycloalkene and a hydrogenation catalyst and without the removal or neutralization of the reaction mixture. The yield was 88%. In the Comparative example 5, representative of the prior art, the process is conducted with a basic Michael-type addition catalyst and the subsequent step is conducted in the presence of a hydrogenation catalyst without removal or neutralization of the reaction mixture. The yield is 75%. The applicants' process gives a superior yield even without the uneconomic removal or neutralization of the reaction mixture. This result is not suggested by the prior art.

A copy of H.A. Bruson, Organic Reactions, Vol. 5, page 90 is submitted herewith for the convenience of the examiner.

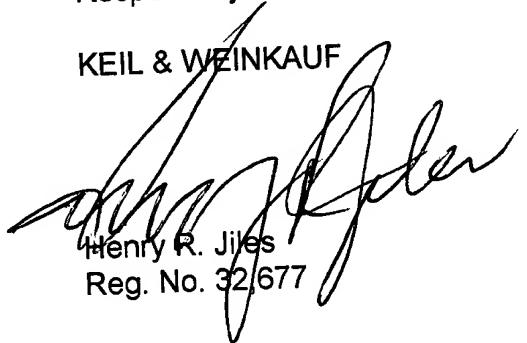
In view of the foregoing amendment, the comparative data in the specification and the remarks, the applicants respectfully urge that the claimed invention is patentable and allowance of the claims is solicited.

FRIEDRICH et al., Serial No. 09/235,242

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Respectfully submitted,

KEIL & WEINKAUF

A large, stylized handwritten signature in dark ink, likely belonging to Henry R. Jiles, is written over the printed name and registration number.

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